

REMARKS/ARGUMENTS

Claims 1-36 remain pending in the application. Claims 1-36 are rejected. No new matter has been introduced into the application. As explained in more detail below, the Applicants submit that all claims are now in condition for allowance and respectfully request such action.

Rejection under 35 U.S.C. §102

Claims 1-2, 4-5, 7-9, 15-19, 21-22, 24-26, 32-34 and 36 are rejected under 35 U.S.C. §102(e) as allegedly being anticipated by *Emerson, III* (2003/0043974). The Applicants traverse the rejection in view of the Remarks below.

The Office Action maintains the allegation that paragraphs 0039 and 0040 of Emerson teach a method wherein a first user selects a caller ID associated with an identity of the first user and then transmitting, upon selection, the caller ID to at least one contact from a list of contacts selected from the user's database. Specifically, the Office Action asserts that the phrase "transmitting, upon selection, the caller ID" "does not limit whether to transmit the caller ID immediately or at a later time." (Office Action dated February 17, 2006, page 6). The Applicants respectfully disagree with the Office Action as the phrase "upon selection" places a time-frame on transmitting the caller ID. Indeed, it is transmitted upon selection.

As recognized by the Office Action, the claims are read in light of the specification. The Specification makes it clear that "upon selection" of the caller ID, it is transmitted to at least one contact before a call is established. "[A]spects of the invention relate to a method that can be used to deliver selected identification information from one user to another user before communication has been established. (Paragraph 1, lines 2 – 4).

Further, under the heading “Identifier Selection and Transmission Process”, the Specification states: “In step 415, after the user has finished selecting a new identifier, the new identifier is stored in at least one of a plurality of databases...When receiving a new identifier, the database may automatically trigger a background transmission process that sends the new identifier to at least one of the applicable contacts as is described in step 420.” (Paragraph 40, lines 1 – 2 and 5 – 8). While the use of a background transmission is not required, but rather one preferred method, the Specification is clear that in the claimed embodiment, the transmission is automatically transmitted upon selection. See also paragraph 15; “Multiple people sharing one telephone could change the image or ring tone or sound associations before calling another party and be identified correctly by the called party. Furthermore, those receiving calls would not need to wait until after initiating a conversation to discover the caller’s identity. (emphasis added). Indeed, this aspect is fundamentally different than found in the prior art, including Emerson. Indeed, at the very least, the Specification makes it clear the transmission occurs before calling another party. In this regard, Emerson can be said to teach away from the rejected claims.

In fact, as discussed in the Response dated 12/08/05, the Applicants demonstrated that paragraphs 0039 and 0040 of Emerson set forth the transmission of profile information in a canned message to be transmitted, for example, as combined with E-card, in which the E-card “can be sent to the called system during call setup”. (Paragraph 0040; emphasis added). Indeed, transmitting profile information is performed in the context of initiating contact, such as a call, with another user. (*See also* paragraph 0035; stating “user profile information is sent to and exchanged with corresponding systems in the call setup process, particularly in the circumstance of a failed call setup attempt due the called party not answering”; emphasis added); and

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paragraph 42 (the E-card may alternatively be “passed to the other party on demand after call setup”).

The Applicant further disagrees with the Office Action’s assertion that the recited features of Emerson that the Applicant sets forth to show the differences among the references are features that the Applicants are relying on and thus be recited in the claims. Rather, the Applicants were merely showing the recited features of the reference demonstrate Emerson cannot be said to teach or suggest “transmitting, upon selection” as recited in the rejected claims, but rather teach away from the claim limitation.

Specifically regarding independent claim 18 and the claims that depend thereof, there is also no teaching in Emerson of “transmitting, upon selection, the first user’s selected caller identification to a list of contacts selected from the first user’s contact database”. As discussed above, Emerson shows the transmitting of information to a called party. There is no teaching to transmitting the identification to a list of contacts, but rather only to the called party. Therefore, for at least these reasons, the Applicant respectfully requests reconsideration and withdrawal of the rejection.

Rejection under 35 U.S.C. §103

Claims 3 and 20 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Publication No. 2003/0043974 to *Emerson, III* (“the ‘974 application”) in view of U.S. Pat. No. 6,873,861 to *Awada et al.*, (“the ‘861 patent”). The Applicants traverse the rejection in view of the Remarks below.

In response, the Applicants submit the rejected claims are not obvious in view of the cited references. As discussed in detail above, Emerson does not disclose transmitting, upon selection, the caller identification to at least one contact from a list of contacts selected from the first user's contact database. This limitation is not met or otherwise suggested by Awada, which is directed towards transmitting business cards during a phone call. Indeed, the text cited by the Examiner states "the business card data is encoded by the cellular phone and transmitted over the cellular network to the party or parties engaged in the phone call. (Col. 4, lines 51-53; emphasis added).

Moreover, claims 3 and 20 further limit the element "selecting, by a first user, a caller identification associated with an identity of the first user" as recited in the claims. In contrast, the cited text of Awada concerns the transmission after a business card has already selected and stored. For at least these reasons, combining Emerson with Awada does not suggest the subject matter of the rejected claims. The Applicant, therefore, respectfully requests reconsideration and withdrawal of the rejection.

Claims 6 and 23 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Publication No. 2003/0043974 to *Emerson, III* ("the '974 application") in view of U.S. Patent Publication No. 2002/0052921 to *Morkel* ("the '921 application"). The Applicants traverse the rejection in view of the Remarks below.

In response, the Applicant submits the rejected claims are not obvious in view of the cited references as the teaching, motivation, or suggestion to make the claimed combination. As discussed in detail above, Emerson does not disclose transmitting, upon selection, the caller identification to at least one contact from a list of contacts selected from the first user's contact database. This limitation is not met or otherwise suggested by Morkel. The Office Action

asserts that Morkel teaches transmitting the Caller ID to the list of contacts (page 1, para. 0007, page 2, para. 0011, and page 3, para. 0035) for the purpose of securely acquiring, handling, and maintaining contact information (page 1, para. 0002 and 0006). The cited paragraphs do not read upon the rejected claims. For example, claim 6 recites:

The method of claim 1, wherein the step of transmitting, upon selection, the caller identification to a list of contacts selected from the first user's contact database further comprises:

transmitting the caller identification to the list of contacts through a background transmission process.

In contrast, the cited text of Morkel sets forth that a user can attach a message to an email directed to a recipient indicating that personal information is included in the message (para. 7, 11, and 35). Therefore combining Emerson with Morkel does not suggest the subject matter of the rejected claims, therefore, for at least these reasons the Applicant respectfully requests reconsideration and withdrawal of the rejection. In the alternative, the Applicant requests clarification on where Morkel teaches such a background transmission process and how one skilled in the art would have been motivated to make such a combination.

Claims 10 and 27 are rejected under 35 U.S.C. §103 (a) as being unpatentable over U.S. Patent Publication No. 2003/0043974 to *Emerson, III* ("the '974 application") in view of U.S. Pat. No. 6,442,263 to *Beaton et al.*, ("the '263 patent). The Applicants traverse the rejection in view of the Remarks below.

In response, the Applicant submits the rejected claims are not obvious in view of the cited references as the teaching, motivation, or suggestion to make the claimed combination. As discussed in detail above, Emerson does not disclose transmitting, upon selection, the caller

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identification to at least one contact from a list of contacts selected from the first user's contact database. This limitation is not met or otherwise suggested by Beaton.

Therefore combining Emerson with Beaton does not suggest the subject matter of the rejected claims, therefore, in view of the foregoing, the Applicant respectfully requests reconsideration and withdrawal of the rejection

Claims 11-14 and 28-31 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Publication No. 2003/0043974 to *Emerson, III* ("the '974 application") in view of U.S. Patent Publication No. 2003/0083086 to *Toyryla et al.*, ("the '086 application"). The Applicants traverse the rejection in view of the Remarks below.

In response, the Applicant submits the rejected claims are not obvious in view of the cited references as the teaching, motivation, or suggestion to make the claimed combination. As discussed in detail above, Emerson does not disclose transmitting, upon selection, the caller identification to at least one contact from a list of contacts selected from the first user's contact database. This limitation is not met or otherwise suggested by Toyryla. Indeed, the cited text merely states that groups "may be created and managed by sending standard messages, *i.e.* in a way similar to distributing electronic business cards (and ringtones and logos)." (Page 3, para. 0042). Merely teaching that groups may be created by sending standard messages does not teach or otherwise suggest the subject matter of the rejected claims. Therefore, the Applicant respectfully requests reconsideration and withdrawal of the rejection.

Claim 35 is rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Publication No. 2003/0043974 to *Emerson, III* ("the '974 application") in view of U.S. Pat. No. 5,889,852 to *Rosecrans et al.*, ("the '852 patent"). The Applicants traverse the rejection in view of the Remarks below.

In response, the Applicants submit the rejected claims are not obvious in view of the cited references as the teaching, motivation, or suggestion to make the claimed combination. The limitations of Emerson have been described above. These limitations are not met or otherwise satisfied by the teachings of Rosecrans. Rosecrans is directed towards telephones containing phonebooks and graphical user interfaces for displaying such phonebooks. As provided in the Summary of the Invention, “[t]he present invention is directed to a Graphical User Interface, for use with electronic phonebooks, that links graphical information, e.g. a graphic identifier such as a logo or a picture, to a phone number that may be called using the graphic identifier when displayed on the interface. (Col. 1, lines 60 – 65; emphasis added). While one user may send/receive a photo or logo from another user, the photo or logo is not used for a Caller ID related function when a call is placed. Rather, the teachings of Rosecrans allow a user to choose a picture or logo (which may have been received from another user) representing a person or business to place a call rather than choosing the actual collection of digits comprising the phone number to call. In this regard, Rosecrans allows the calling party to review and possibly select the picture or logo and does not teach or otherwise suggest the subject matter of the rejected claim. In this regard, there is no teaching or motivation to combine the references, and upon doing so, the subject matter of the rejected claims is not taught or otherwise suggested. Therefore, for at least these reasons, the Applicant respectfully requests reconsideration and withdrawal of the rejection.

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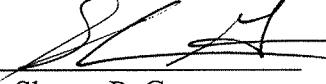
CONCLUSION

It is believed that no fee is required for this submission. If any fees are required or if an overpayment is made, the Commissioner is authorized to debit or credit our Deposit Account No. 19-0733, accordingly.

All rejections having been addressed, applicant respectfully submits that the instant application is in condition for allowance, and respectfully solicits prompt notification of the same. Should the Examiner have any questions, the Examiner is invited to contact the undersigned at the number set forth below.

Respectfully submitted,
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Dated: April 17, 2006

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